

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : O'DONNELL ET AL. Confirmation No. : 5408
Application No. : 09/245,798 Group Art Unit : 3623
Filing Date : FEBRUARY 5, 1999 Examiner : BOSWELL, B. V.
Docket No. : 1690-001-01 Customer No. : 00996
Title : AUTOMATED LICENSING AND DELIVERY OF COPIES OF
WORKS OF AUTHORSHIP, WITH PROOF OF LICENSE

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF
37 CFR §41.41

Sir:

In response to the Examiner's Answer mailed July 8, 2009, in the instant application, Appellants hereby submit this Reply Brief.

No fee is believed to be due in this instance. The Commissioner is hereby authorized to charge any deficiency of fees submitted herewith, or credit any overpayment, to Deposit Account No. 07-1897.

37 CFR §1.8
CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system, EFS-Web, addressed to the Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on the date indicated below.

/Lisa S. Susser/
Lisa S. Susser

8 September 2009
Date

Real Party In Interest:

The inventor, Mike O'Donnell, and an assignee US corporation of which he is an owner, iCopyright, Inc., which makes and uses in the US, and licenses others to make and use, embodiments of the invention.

Related Appeals and Interferences:

None.

Status of Claims:

Claims 126-147 stand rejected. Applicants hereby appeal the Examiner's rejections of claims 126-147.

Status of Amendments:

No amendment has been filed after the final rejection.

Summary of Claimed Subject Matter:

Each independent claim is separately addressed.

Claim 129 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, acknowledging acceptances without intermediate human activity, and publishing on a publicly accessible network records of licenses granted, comprising:

(a) presenting on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged; and

(f) storing a record of the accepted license and making the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 129 in the Specification (emphasis added):

At Page 1, Line 8

BACKGROUND OF THE INVENTION

"This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use."

At Page 1, Line 30

"The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or

their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

"Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work."

SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license."

At Page 3, Line 13

"In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted...The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted."

At Page 4, Line 25

"When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

Claim 145 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, acknowledges acceptances without intermediate human activity, and publishes on a publicly accessible network records of licenses granted, comprising:

(a) a registration web page server component that presents on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver component that receives from the third computer on the network a message indicating acceptance of the offered terms and responds to the third computer with a message that the acceptance has been received and acknowledged; and

(f) a proof of license web page server component that store a record of the accepted license and makes the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 145 in the Specification (emphasis added):

At Page 1, Line 8

BACKGROUND OF THE INVENTION

"This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use."

At Page 1, Line 30

"The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

"Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These

methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work."

SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license."

At Page 3, Line 13

"In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted...The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted."

At Page 4, Line 25

"When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the

license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

Claim 126 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 126 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines

the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Claim 128 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, printing a copy of a work, comprising:

(a) presenting, on a computer network, license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and requesting that a paper reprint be delivered, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and

(f) after the message indicating acceptance and reprint request is received, as a consequence of having received the acceptance and request, the clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery.

Support for claim 128 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques."

Claim 138 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmits a copy of a work, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a

first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and the request, sends to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 138 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in

an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques."

Claim 142 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response

to acceptances, without intermediate human activity, prints a copy of a work for delivery to a licensee, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for a paper reprint, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, after the message indicating acceptance is received and as a consequence of having received the acceptance, sends to a printer a copy of the work of authorship for printing on paper and delivery.

Support in the Specification for claim 142 (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the

article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document

fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Grounds of Rejection to Be Reviewed on Appeal:

Claims 126-127, 129-131, 138, and 145 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.);

Claims 128, 142, and 146-147 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com);

Claims 133 and 139 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of US 6,119,108 (Holmes et al.);

Claims 136-137 and 143-144 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com) and in further view of US 6,119,108 (Holmes et al.); and

Claims 132, 134-135, and 140-141 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Digital Object Identifier (DOI) system.

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Argument:

Rejection of claims 126-127, 129-131, 138, and 145 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.)

The issue for these claims is focused on whether a method or system with the last element is obvious. The last element is:

“making the record available for look-up by anyone from any computer on the publicly accessible network.”

In the final office action, the Examiner asserts that this element is obvious because “Johnson et al discloses a publicly accessible network and storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network”. It is true that Johnson teaches making the record available for look up by persons with certain management authorization, but Johnson does not teach making it accessible “by anyone”. Johnson explicitly teaches away from making it accessible by anyone.

The Examiner maintains that, because Johnson teaches “that potential licensees are allowed access to the system,” it is therefore obvious that anyone might be allowed access to all the records of what licenses have been granted and to whom. This does not follow. Just because all people are allowed access to some parts of the system and only administrators are allowed access to the records of what licenses were granted and to whom, it is not obvious that ALL people should be allowed access to the records of WHAT LICENSES WERE GRANTED AND TO WHOM. Johnson teaches that only administrators should have access to these records.

All web sites that are accessible on a network have some components that are accessible to more people and some components that are accessible to fewer people. There is no web site where all components have the same degree of availability to all. These differences are generally established by adjusting “security settings.” For example, for most web sites, only the site administrator or the host operator can delete files, and there are typically some files for the web site that even the site administrator can not delete and can not fully erase by writing over each spot on the

hard disk where the data was stored, this function being limited to the host operator. As a more relevant example for the present issue, the site administrator usually has the power to revise any data that is presented on the site and others usually have very limited power or no power to revise data that is presented on the site. It is also common that a site will allow the world to view certain data collected at the site and allow only the site administrator to view other data collected at the site, such as number of site visits or IP addresses of visitors.

In Johnson, only the site administrator is allowed to view records of who had obtained a license to use a work of authorship. This information is not made available to the general public. The question that the applicant and the Examiner are grappling with is whether making this information available to the general public is obvious. Although this change from the prior art can easily be made by a programmer, this does not answer the question of whether it was obvious to do so.

The body of the application quoted above articulates extensively that making this information available to the general public is non-obvious and is an important invention over the then prior art relating to controlling uses of copyright protected works of authorship.

As described in quoted sections of the application above, the invented method is a solution to the problem of easy unauthorized copying of works of authorship that is completely different from the prior art solutions to this problem. Johnson does not even attempt to address this problem. There is nothing in the prior art, especially not in Johnson, which suggests this solution to the problem or motivates this solution to the problem. The prior art solutions of technical copy restriction and watermarking and the like all teach away from this solution. In contrast to the prior art technical solutions, the invention exploits the fact that humans are social animals and care what other people think of them when their actions are published for anyone to check on.

There is no teaching in Johnson that provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner. The examiner points out that "potential licensees" are allowed to access certain data in the system. However, they are not allowed to access "a record of the accepted license" as specified

by the last element of claims 129 and 145. The fact that they are members of the general public and are allowed access to some data does not make it obvious that they should be allowed access to other data to which only administrators are allowed access as taught by Johnson.

Thus, the examiner has not made a prima facie case of obviousness. Independent method claim 129 and the corresponding system claim 145 should be allowed, along with the claims that depend from them.

Independent method claim 126 and its corresponding system form claim 138 are rejected under §103 as unpatentable over Johnson (US 5,991,876).

With respect to the point of novelty of claim 128, the Examiner is misreading Johnson. Johnson does not teach or suggest that a person could place an order for a “copy” of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are “rights”. The “rights” that may be ordered in the system taught by Johnson are so intangible that they have no embodiments. There is no “copy” of any right that may be ordered. The “right” is actually a legal release by a copyright holder in favor of the person to whom the right is granted, so that the licensee can not be successfully sued by the copyright holder for infringement of copyrights, provided certain limitations on the “right” are followed.

Johnson makes clear that the only properties offered by the system are rights and not copies. In column 3, Johnson states: “A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials.” (Emphasis added) In column 8 lines 15 - 20 Johnson states “during the first year of the contract, rights are offered at a base fee During the second year of the contract, rights are offered at a base fee of”

Details of the ordering capabilities of the system are discussed in column 9 beginning at line 35 where Johnson states that the order table “provides a dynamic log of right authorizations and denials”. At lines 45 - 48 Johnson states: “Order_right field 448 contains a reference or link to a right_instance field 410 of rights table 408. This link identifies the right ordered.” (Emphasis added)

In column 10 at lines 42 - 45, Johnson states “User interface 700 includes a view of a constructive index card 702 to specify a particular right for which authorization is sought.” (Emphasis added)

Applicant respectfully submits that the Examiner is repeatedly misreading Johnson. In particular, where the Examiner states on page 9: “See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60”, none of these passages, when read carefully, supports the Examiner’s view. Each of these passages refers to a “right” and not a copy of a work of authorship.

Figure 7 does not teach that the system may offer, or a user may receive “a copy of the work of authorship”. Figure 7 teaches that, when a prospective licensee requests a license, the licensee may be required to specify whether the type of use will be on paper or electronic and the number of copies that the licensee wishes to make. The fact that a user is requested to state what kind of use the user will make of the rights obtained does not imply that the server can send a copy of a work of authorship. Figure 7 does not teach that a user of the server system may place an order for a copy to be delivered, in any form, or that the server system is capable of delivering a copy in any form.

In column 7 at lines 1 - 10 Johnson states that the types of works for which copyrights might be licensed and managed by the system include works that may be embodied in electronic copies. However, Johnson says nothing about delivering electronic copies of those works to licensees.

In column 7 at lines 40 - 55, Johnson explains that the type of use for which a prospective licensee may seek permission may be specified, such as: educational, not for profit, commercial, on paper, in an optical memory, in a computer memory serving an intranet, or in a computer memory serving the internet. This paragraph in Johnson does not teach either that a prospective licensee can place an order for a copy of a work of authorship or that the system could be made capable of delivering a copy of a work of authorship.

In column 9 at lines 35 - 55, Johnson states that the right ordered might be the right to make electronic copies of the work. However, Johnson says nothing about allowing the licensee access to an electronic copy of the work to make these copies.

This paragraph of Johnson merely teaches that “rights” can be ordered, not that copies can be ordered or that the system has the ability to deliver the work upon acceptance of the license.

In column 10 at lines 40 - 60, Johnson discusses the user interface through which a prospective licensee will place an order for rights. When the prospective licensee places the order, the licensee may be required to specify whether the use will be made on paper or electronically and the number of copies that the user will make. This paragraph of Johnson does not teach either that the prospective licensee may place an order for copies or that the server system can deliver copies.

Thus, Johnson does not teach or suggest that a person could request or receive a “copy” of a work of authorship. Although each person in Johnson who orders a “right” relating to a work of authorship (in contrast to other kinds of property with which the system in Johnson is also designed to work) must have a copy of the work of authorship (or the original) to exercise that right, Johnson does not address how the person might get such a copy. Presumably, they already have a copy -- otherwise they would not know that they want a right to make copies or other copyright restricted uses of it. Element (e) of claim 126 specifies that a copy of the work of authorship is not provided across the network until after the user has accepted the terms of an offered license.

Even if one were to assume that a person who needs source materials to exercise the right they bought might, in some cases, be able download those materials from a site on the World Wide Web, Johnson does not suggest or imply that the materials might be delivered “as a consequence of” the person having indicated “acceptance of the offered terms and request for an electronic copy”. This is the crux of the matter.

The question then is whether it is obvious that the system of Johnson might be improved to add a feature that, once a customer buys a right to use materials by accessing a server across a network, the server will then offer a chance to request that a copy be sent across the network and, if the customer requests such a copy, it is automatically sent to the customer across the network.

Under US patent law, some improvements are patentable and some improvements are obvious and therefore not patentable. The Applicant submits that, if it were obvious to make the claimed improvement to the system of Johnson, it would have been done between the date the Johnson application was filed in 1996 and the date the present application was filed three years later. This is a field in which there was intense inventive activity during those years.

The Johnson patent application discloses inventions made by the Copyright Clearance Center (CCC). In 1996, when the Johnson application was filed, the CCC did not maintain a computer system for providing copies of works of authorship across the Internet to general public licensees. The CCC provided (and still provides) a service to publishers to help them grant licenses ("rights") to use their published works of authorship. The publishers published their works in various forms including electronic. Members of the public who saw or received a reference to one of those works could then go to the CCC to obtain a license to make a use of the work that was otherwise prohibited by copyright law. The licensees obtained their source materials directly or indirectly from the publishers, not from CCC.

Thus, neither the system then publicly disclosed by CCC nor the system taught by Johnson is sufficient to implement the invention. A link is required to a database that contains copies of the works of authorship in question. Such a link is not suggested by Johnson. The Johnson system does not store the work itself or even have a link with access to a database containing such works. A prospective licensee has to access the Johnson system and enter the title of the work or the author's name in order to locate the licensing rules for the work. If the prospective licensee decides to license the content based on the stated rules, they pay the administrator of the Johnson system. There is no stated mechanism for how a copy of the licensed content might be delivered to the licensee. The assumption is that the user already has a copy of the work and is simply paying for rights to copy it or otherwise do something with it other than merely read it. It is not obvious from Johnson to provide these functions because the repository only stores rights information about the work, it does not store the work itself.

To make a prima facie case that an improvement over Johnson is obvious, the Examiner must point to a teaching, suggestion, or motivation in the reference itself or in the knowledge generally available to one of ordinary skill in the art that the improvement should be made to the prior art system. The claimed concept may seem obvious now, but it was not obvious when the present patent application was filed in 1999, particularly for a system “usable by a plurality of publishers” as specified by element (a) of claim 126. Applicant submits that the present inventor was the first to invent the claimed method of automatically doing so upon request as part of a transaction to secure the rights and that this is a significant invention.

Claims 126 and 138 are therefore allowable.

Dependent claim 127 is allowable for at least the same reasons discussed above with regard to independent claim 126 from which claim 127 depends.

Dependent claims 130 and 131 are allowable for at least the same reasons discussed above with regard to independent claim 129 from which claims 130 and 131 depend.

Rejection of claims 128, 142, and 146-147 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com)

Claims 128 and 142 stand rejected under §103 as unpatentable over Johnson (US 5,991,876) in view of a reference (Elsevier) showing that a service of a human providing paper reprints of works of authorship in response to a request posted via a computer network was in the prior art. There are many such references that could be cited for this proposition.

The essential question is whether it was obvious to modify this service to be performed automatically, without human intermediation, and combine it with a server for granting reprint licenses such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then automatically be sent by the server system to a printer for printing on paper and delivery.

To address this question, Applicant begins by noting, as did the Examiner, that a combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance.

In 1996 when the Johnson application was filed, the CCC did not maintain a computer system that was capable of sending copies of works of authorship to a printer for printing reprints. Thus, neither the system then used by CCC nor the system taught by Johnson is sufficient to implement the invention. In addition, a link is required to a database that contains printable copies of the works of authorship in question. Such a link is not suggested by Johnson or Elsevier.

The Examiner asserts that Johnson teaches “the third computer/client requests the order of paper copies be supplied,” citing figure 7, column 7 lines 40 - 55, column 8 lines 1 - 22, column 9 lines 35 - 55, and column 10 lines 40 – 60. This is not correct. All of these parts of Johnson have been discussed above with respect to this issue except for the column 8 reference.

In column 8 at lines 1 - 22 Johnson discusses the rights table which holds information about rights granted. Again, the granting of a right is not the delivery of a copy. It is not the delivery of anything. Although the price to be paid by the prospective licensee as discussed in this paragraph of Johnson may vary according to the number of copies that the licensee is authorized to make, this section of Johnson does not teach that the prospective licensee may place an order for someone else to make the copies or that the server system may provide copies.

The Examiner argues her reading of Johnson is supported by the fact that Johnson mentions that educational institutions make copies of documents to create course packets. This fact reported by Johnson does not support the Examiner’s position. It does not suggest or teach that the clearinghouse server system should allow users to place orders for copies of works authorship or that the server system should deliver ordered copies of works of authorship.

Claims 128 and 142 are therefore allowable.

Dependent claim 146 is allowable for at least the same reasons discussed above with regard to claim 128 from which claim 146 depends.

Dependent claim 147 is allowable for at least the same reasons discussed above with regard to claim 142 from which claim 147 depends.

Rejection of claims 133 and 139 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of US 6,119,108 (Holmes et al.)

Dependent claim 133 depends from independent claim 126 and is allowable for at least the same reasons discussed above with regard to claim 126.

Dependent claim 139 depends from independent claim 138 and is allowable for at least the same reasons discussed above with regard to claim 138.

Rejection of claims 136-137 and 143-144 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com) and in further view of US 6,119,108 (Holmes et al.)

Dependent claim 136 depends from independent claim 128 and is allowable for at least the same reasons discussed above with regard to claim 128.

Dependent claim 137 depends from claim 136 and accordingly is allowable for at least the same reasons as claim 136.

Dependent claim 143 depends from independent claim 142 and is allowable for at least the same reasons discussed above with regard to claim 142.

Dependent claim 144 depends from claim 143 and accordingly is allowable for at least the same reasons as claim 143.

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Rejection of claims 132, 134-135, and 140-141 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Digital Object Identifier (DOI) system

Dependent claim 132 depends from independent claim 129 and is allowable for at least the same reasons discussed above with regard to claim 129.

Dependent claim 134 depends from independent claim 126 and is allowable for at least the same reasons discussed above with regard to claim 126.

Dependent claim 135 depends from claim 134 and accordingly is allowable for at least the same reasons as claim 134.

Dependent claim 140 depends from independent claim 138 and is allowable for at least the same reasons discussed above with regard to claim 138.

Dependent claim 141 depends from claim 140 and accordingly is allowable for at least the same reasons as claim 140.

Response to Examiner's Answer:

Before getting into the particulars of the claims and arguments, it may be helpful to provide an overview of the system taught by the present patent application. The material below consists of illustrative examples. The examples below were copied from a computer display as the system has been implemented. Each of the features discussed below is taught in the original specification.

See below a sample article from a web page of a publication that has implemented the invented system. (The reader is invited to go to www.ap.org and select any of the stories under "AP News on Media Sites".)

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Jul 8, 1:07 AM EDT

German Chancellor Angela Merkel upbeat on G-8, but progress on climate change slow

By TOM RAUM
Associated Press Writer


TOYAKO, Japan (AP) -- President Bush and German Chancellor Angela Merkel pledged Tuesday to keep working together on common problems, but progress appeared slow on reaching a consensus on climate change as the Group of Eight major economies tackled that and other knotty global




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Unlike Johnson, to receive the above re-use offers, the user never sought a centralized repository of licensing information. Unlike Johnson, the user didn't need to request a specific publication or article from a database. Instead, the user is offered the licensing opportunities right at the viewed article itself. Unlike Johnson, the user need not navigate through a plethora of licensing opportunities for a plurality of publications, but is presented with licensing opportunities only for the publication he was viewing.

Now, suppose the user accepts one of the re-uses offered to him for that article. Unlike Johnson, the content is automatically delivered to the user. Depending on the type of re-use selected by the customer this could mean overnight delivery of reprints, a formatted electronic version of the article for use on a website with embedded advertising, a formatted electronic version of the article without ads, an e-mailable form of the article, etc. Whatever the type, (1) the execution of the license is accompanied by delivery of the content, and (2) the content that is received will have a proof of license embedded. Neither of these is contemplated by Johnson; each is valuable and non-obvious, and the combination is revolutionary.

The screen shot below shows an example of what the purchaser/licensee sees upon completing a transaction to obtain a license for one particular re-use service (the right to make copies on one's desktop printer). Please note the sentence "This is your confirmation that your photocopy license has been accepted and your photocopy master is ready for printing." That is, the customer is simultaneously receiving a license and a formatted version of the content for his re-use purposes.

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July 8, 2008

Bush, German leader meet on G-8 challenges

By TOM RAUM
Associated Press Writer

President Bush and German Chancellor Angela Merkel pledged Tuesday to keep working together on common problems, but progress appeared slow on reaching a consensus on climate change as the Group of Eight major economies tackled that and other knotty global

[remainder of article omitted]

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Since the license can be instantly verified, the mere appearance of this license tag on an article serves as a strong indication of legitimacy. Similarly, and more importantly, once the system is ubiquitous, the absence of such a license tag provides strong indication of non-legitimacy. So the ability of everyone to click on the license tag to instantly see if the re-use is legitimate is very important. But great value is also provided simply by having the license tag there even if no one clicks on it.

To illustrate the importance of this approach, consider an HOV (High Occupancy Vehicle) lane. Why do HOV lanes work so well? The HOV lane is free of charge and uncrowded. Statistically, violators are rarely stopped and caught -- there aren't enough police to catch most violators. So why doesn't everyone violate the law and use it even when there is a single occupant in the car? The answers, of course, are social conscience and the risk that another driver (a "peer" or "competitor") will make a cell phone call to report your violation. Because car windows are transparent, a car with a single passenger traveling in an HOV lane will be immediately visible to all other travelers. He will be the object of scorn, as his behavior is considered unfair to all other travelers on the highway. He might be reported by a peer or competitor. The invented license tag system is based on the same principle. If you don't have a license tag at the bottom of your re-used content, it is a highly public, immediately visible admission of infringement. Like the violator in the HOV lane, the transparency of the system and communal interest in compliance reduces violation to low levels even without (a) a mechanical system to prevent violation or (b) policing, other than by peers, to catch violators.

Note that the system works because of (i) the ease of obtaining the license in the first place so it becomes ubiquitous (not taught by Johnson), (ii) the immediate and automated delivery of the content in an appropriate format with the license tag included (not taught by Johnson), (iii) the ability of any reader to immediately verify the license is legitimate by clicking on it (or, for hard copy, inputting in a browser)(not taught by Johnson), and (iv) the transparency, public shaming, and risk of peer enforcement that violators are subject to by not having a license tag on re-used content (also not taught by Johnson).

Let's return to the innovation of delivering the formatted content simultaneously with issuance of the license. While the automated delivery of the formatted content makes re-use convenient and attractive for the customer, it serves another function -- it ensures that the version the customer re-uses has the license tag at the bottom! Without the automated delivery, the customer would simply "cut and paste" or xerox the licensed content, and the licensed content would appear without the license tag at the bottom. Like an HOV lane where all cars have tinted windows and no

license plate, transparency would disappear and the whole system would collapse. There is no reason a person of skill in the art would think to implement automated delivery if he weren't trying to insert a license verification tag at the bottom. The concept of delivering a license and reformatted content simultaneously arises in large part because of the need to insert a license verification tag at the bottom of the re-used content.

Unlike prior art, this system is not based on centralized offering pages of permissions that a user seeks out in order to request a re-use permission. Rather, the permission is actively offered to the user without being sought, is offered at the point of interaction with the content, and is offered specifically for that piece of content alone. Unlike prior art, this system addresses the problem of copyright infringement without mechanical or digital obstructions to infringement. Unlike prior art, this system delivers the content appropriately formatted with proof of compliance inserted. The license verification tag allows anyone to verify the validity of the license and the absence of the tag indicates a high probability of infringement (and, as the tags become ubiquitous, a certainty of infringement). This system bears little resemblance to any prior art systems and overcomes the failings of all previous systems.

Regarding Claims 129 and 145

Like the opening brief, this reply brief focuses first on method claim 129 and corresponding system claim 145, because those are the most important and most revolutionary pending claims. The examiner's argument about these claims is contained in one paragraph in the middle of page 7 of her brief and on pages 20-22.

Claims 129 and 145 concern methods for rights management – reducing unauthorized copying of works of authorship. All of the prior art before the present application focused on technical means to either make it very difficult for unauthorized would be copiers to make copies (copy protection) or make it technically provable if they did so (such as via “watermarks”). No prior inventors in this field approached the problem from an understanding that humans are social animals and that their behavior is affected by social pressure, a basic desire to do the right thing, and the effectiveness of giving peers an enforcement tool but offering no compensation to the enforcers.

The inventor of claims 129 and 145 recognized these aspects of human nature and devised a technical means to take advantage of them to discourage unauthorized copying. He set up a system where it can become the social norm to offer easily verifiable proof of authorization in the form of a web page accessible by anyone from any computer with access to the world wide web so that anyone can easily verify whether authorization was given for any copied work of authorship. This allows peers and competitors – who have an incentive to do so -- to check whether license fees were paid and rat on violators if they were not.

In her paragraph on page 7, the examiner says, in effect, that the Johnson system has all the required hardware and even has all the database fields set up. To convert the system of Johnson to the claimed system, all one must do is write a simple report generator routine that is accessible to anyone on the world wide web. The report generator routine would report out selected information from the database. True enough. But the mere fact that it is easy to create the claimed system does not mean it is obvious to create that system.

All of the prior art systems to discourage unauthorized copying teach nothing like what is claimed. For this reason, the examiner has cited none of them in her rejection. Johnson does not disclose a system or method to discourage unauthorized copying. The system of Johnson is for would-be copiers merely to obtain authorization to copy – it teaches nothing about discouraging unauthorized copying. Johnson teaches that the data in the database fields indicating whether a license for a use has been granted should not be made viewable by the general public but should be made viewable only by administrators. Thus, Johnson teaches away from the claimed invention.

The examiner states that it is well known that any data fields associated with a web site can be given a low security level so that anyone can view them. True. But this is not the claimed invention. The claimed invention is a combination of such a security setting with the other elements of the claim. All prior art systems with the other elements of the claim had high security settings for these data fields to make them viewable only by an inner circle of people, and no prior art developer published the idea there could be any advantage to making those data fields – or lack of such data fields --

viewable by everyone and this would present an advantage that would outweigh the loss of confidentiality.

One approach to assessing whether an invention is obvious consists of:

(a) identifying the closest prior art, i.e., the most relevant prior art;
(b) determining the objective technical problem, i.e., determining, in the view of the closest prior art, the technical problem which the claimed invention addresses and successfully solves; and

(c) examining whether or not the claimed solution to the objective technical problem is obvious for the skilled person in view of the state of the art in general.

This last step is conducted according to the "could-would approach". Pursuant to this approach, the question to address to assess whether an invention is obvious is the following (climax of the problem-solution approach):

Is there any teaching in the prior art as a whole that would, not simply could, have prompted the skilled person, faced with the objective technical problem formulated when considering the technical features not disclosed by the closest prior art, to modify or adapt said closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves?

If the skilled person would have been prompted to modify the closest prior art in such a way as to arrive at something falling within the terms of the claims, then the invention is obvious.

The point is not whether the skilled person could have arrived at the invention by adapting or modifying some prior art, but whether he would have done so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage.

As stated above, this approach requires an identification of the problem to be solved and then examination of the prior attempts to solve the problem. As stated in the specification of the patent application, the problem to be solved is how to discourage unauthorized copying. Although there is much prior art addressing this problem, the examiner did not cite this art because it teaches away from the claimed invention. For

this reason, the Applicant maintains that the examiner has not made a prima facie case. Considering the approach to solving this problem taken in the prior art, the applicant's approach is surprising. His approach is to set up no impediments to copying and instead provide a social incentive for the copier to get an authorization because anyone can easily verify via the world wide web whether an authorization was obtained.

Another approach to the issue of obviousness is articulated in *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d. 1340, 1348 (Fed. Cir., 2000) which states that there must be a suggestion or teaching in the prior art to combine elements shown in the prior art in order to find a claim obvious. Thus, in general, the critical inquiry is whether there is something in the prior art to suggest the desirability, and thus the obvious nature, of the combination of previously known elements. This requirement is generally referred to as the "teaching-suggestion-motivation" (TSM) test and serves to prevent against hindsight bias (*In re Kahn*, Fed. Cir. 2006). As almost all inventions are some combination of known elements, the TSM test requires a patent examiner to show that some suggestion or motivation exists to combine known elements to form a claimed invention.

In this case, the examiner has not cited in the prior art any teaching, suggestion, or motivation for creating a system where any authorization granted to each authorized copier can easily be verified by anyone at any time.

The U.S. Supreme Court addressed the TSM test in *KSR v. Teleflex* (2006). The decision overturned a decision of the Federal Circuit and held that it "analyzed the issue in a narrow, rigid manner inconsistent with §103 and our precedents," referring to the Federal Circuit's application of the TSM test. The court held that, while the ideas behind the TSM test and the Graham analysis were not necessarily inconsistent, the test of nonobviousness is the Graham analysis.

The factors a court should consider when determining obviousness were outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966) and are commonly referred to as the "Graham factors". The court held that obviousness should be determined by looking at

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;

3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

In this case, factor 3 is illuminating. The claimed solution to the problem is entirely different from the prior art solutions to the problem. The prior art solutions don't teach, suggest, or motivate a peer-policing method for license verification.

On page 21 of her brief, the examiner argues that it would have been obvious to change the security settings on records of licenses granted to licensees so that anyone can view them because this would have led to predictable results. Presumably, the predictable result the examiner has in mind is that anyone could view them, resulting in a loss of confidentiality. But the Johnson inventors didn't want to compromise confidentiality, and the Johnson inventors did not conceive of the surprising result that social considerations would then incent people to comply with copyright prohibitions, outweighing the negative effects of loss of confidentiality.

Claims 129 and 145 are allowable because the difference from the prior art leads to a surprising result of encouraging copyright compliance.

Claims 126 and 138

In his opening brief, the Applicant showed that the examiner is repeatedly misreading Johnson. Contrary to the examiner's assertion, Johnson does not teach or suggest that a person could place an order for a "copy" of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are "rights". The "rights" that may be ordered in the system taught by Johnson have no embodiments or "copies".

The examiner repeatedly asserts that Johnson discloses "allowing the third computer via the network access to use of an electronic copy of the first work of authorship" (emphasis added). In the middle of page 5 of her brief, using the word "See", the examiner cites six places in Johnson that she asserts support her contention. Then, using the words "See also", the examiner cites again some of the same parts of Johnson and also adds two more places, for a total of eight places in Johnson that the examiner claims supports her contention.

However, the examiner does not quote any of the words from these parts of Johnson or explain how she concludes that these parts teach “allowing the third computer via the network access to use of an electronic copy of the first work of authorship” (emphasis added).

In his opening brief, the Applicant addressed each of the examiner’s “See also” citations and quoted from each one to show that these passages do not teach that a copy of work of authorship may be sent to the third computer but only that a “right” is granted. The examiner did not respond to these assertions by the Applicant in his opening brief. The examiner offered no quotes from Johnson and no explanation of why she thinks these passages disclose what she says they disclose. With respect to those “See also” citations by the examiner, there is no point repeating what the Applicant has already said or quoted. All that remains is for the Applicant to now show that the parts of Johnson asserted by the examiner for the first time in her responsive brief (the “See” citations) also do not contain the disclosure that she asserts they contain. Each “See” citation is discussed in turn below.

Figure 2: Figure 2 teaches nothing relevant. The Johnson specification states: “FIG. 2 shows a block diagram of the components of a computer system to which the present invention applies.” It shows nothing relating to copies of works of authorship or transmission of copies across a network. Here is Figure 2:

FIG. 2

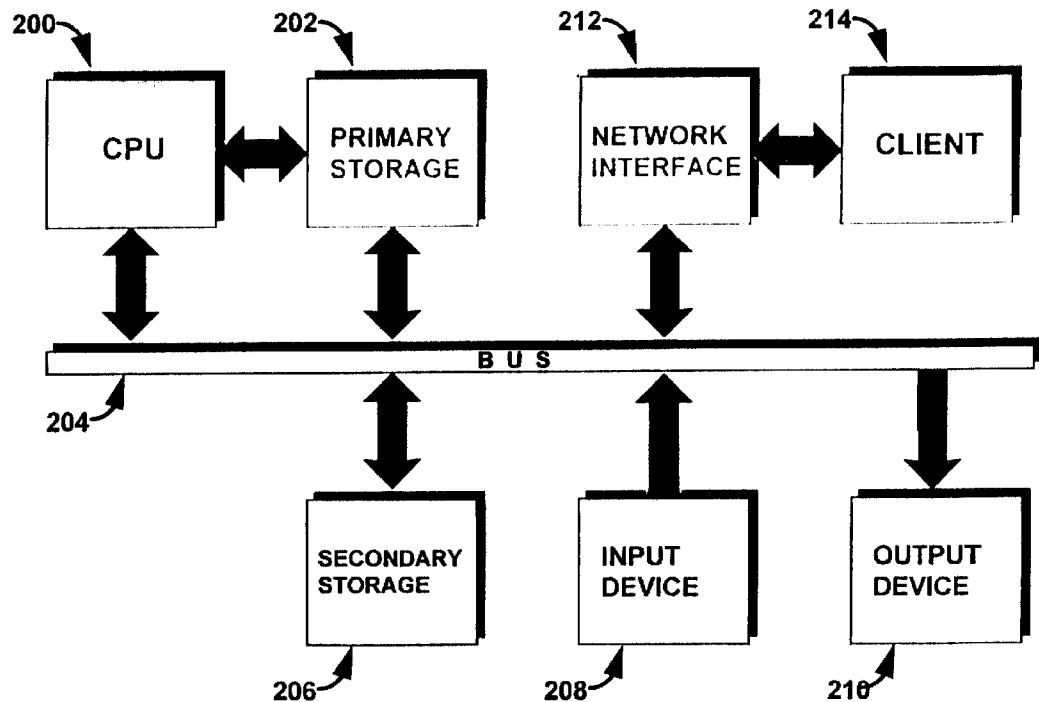


Figure 7: Figure 7 is discussed on page 17 of Applicant's opening brief.

Column 3, lines 25-55: To show that this passage says nothing helpful to the examiner's position, it is quoted below (emphasis added):

Many other enhancements may be added. One such enhancement is the inclusion of a party table to provide detailed data about parties in the system. While parties will generally include all rights holders, parties may include any other individual, group, or organization with a relationship to the rights and authorizations managed by the system. This information may be used for client management, billing and payment, and aggregation functions. A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials. Those of ordinary skill in the art will conceive of other enhancements to the system herein described.

A rights management and authorization system according to the present invention combines this data structure with one or more software programs or tools for

controlling and querying the data structure. Software is provided on the management side for performing work and right maintenance, such as adding, deleting, and editing entries. Software is also provided on the authorization side for querying the database to determine, for example, whether or not to authorize a particular use posed by a potential licensee.

A system according to the present invention may permit rightsholders themselves to add, delete, and edit rights through direct access to the rights management side of the system. A system according to the present invention may additionally or alternatively permit potential licensees to obtain (or be denied) authorizations through direct access to the rights authorization side of the system. Thus, unlike prior art systems, the present invention enables automated rights management and authorization.

Column 4, lines 55-67: To show that this passage says nothing helpful to the examiner's position, it is quoted below:

In some computer systems, input device 208 and output device 210 are connected directly to central processing unit 200, rather than through system bus 204.

While the computer system may be limited to the previous elements, the addition of network interface 212 and client 214 adds flexibility to the system and enables operation under the client/server model of computing. Network interface 212 may be a local-area or wide-area network card, a modem, a gateway to the Internet or an Internet service provider, or a similar interface. Client 214 may be a computer system similar to the one used to implement the present invention, or more typically, a low-cost personal computer of the type used in homes or offices.

Column 9, lines 35-55: This passage is discussed on page 20 of Applicant's opening brief.

Column 9, line 55 – column 10 line 15: To show that this passage says nothing helpful to the examiner's position, it is quoted below (emphasis added):

The data structure from above is combined with one or more software programs or tools for controlling and querying the data structure. Software is provided on the management side for performing work and right maintenance, such as adding, deleting, and editing entries. Software is also provided on the authorization side for

querying the database to determine, for example, whether or not to authorize a particular use posed by a potential licensee. The computer software programs for controlling and querying the data structure may or may not be on the same physical data storage space as the data structure, and often will not be.

On the server side of the system for rights management, favorable results have been achieved with a prototype system based on Oracle Version 7.1.3 database software running under Open VMS on a DEC Alpha 2100. An initial commercial system is contemplated in which Oracle 7.2 is used on a DEC Alpha 8200. On the client side of the system for rights authorization, favorable results have been achieved using personal computers with Intel microprocessors and Microsoft operating systems running object-oriented applications built under PowerBuilder Version 4.0. Those of ordinary skill in the art may select and implement the present invention on other computer systems, and could quickly and easily construct a single-user model from a database system such as Access, dBase, FoxPro, or Quattro. It is contemplated that clients may connect to the server side of the system through Internet connections or some other type of on-line link, and communicate with the system through, for example, TCP/IP and/or DCE protocols, or their equivalent.

Column 10, lines 41-60: This passage is discussed on page 20 of Applicant's opening brief.

In the discussion above and in his opening brief, Applicant has shown that one of the elements of claims 126 and 138 that the examiner asserts is disclosed by Johnson in fact is not disclosed by Johnson.

The examiner concedes, on page 5 of her brief, that Johnson does not disclose "receiving a request for an electronic copy and that the third computer [is] sent, via the network, an electronic copy of the first work of authorship as a consequence of having received the message." But then the examiner follows with another wrong assertion of what is disclosed by Johnson when she says at the bottom of page 5: "the third computer/client is allowed to access and use an electronic copy of the work via the network." The examiner gives no citation for this assertion. As discussed extensively in the opening brief and above, Johnson does not disclose anything about providing copies of works of authorship over a network.

Claims 126 and 138 focus on “A clearinghouse server system / method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work”. It is a clearinghouse method/system. It is “usable by a plurality of publishers” for “a plurality of works of authorship”. The system offers value to both publishers and consumers because it establishes a single clearinghouse where licensing of works of authorship can be transacted. These parts of the claimed invention are not new. They are disclosed by Johnson. What is new is the idea that the clearinghouse system might be improved so that, once a license is obtained, the customer can request, in the same transaction with the clearinghouse, that an electronic copy of the licensed work be sent to the customer so that the customer does not need to go to the publisher to get any needed copy. The applicant’s invention provides instant delivery of a copy of the work being licensed. Johnson does not contemplate delivery of any part of the work, but only the granting of rights to make a copy, or otherwise make use of the work.

The claimed method has important advantages to both the publisher and user above the mere delivery of rights to make a copy. Delivering the copy itself ensures that the owner’s brand, copyright notice, style sheet, i.e., masthead, font, layout, and links are all included with the copy. In prior art systems like Johnson, limited to only granting rights, the licensee is left to make the copies and thus might exclude the important elements delivered by applicant’s invention. Granting rights is one thing. Granting rights plus the copies themselves ensures that the work will be presented optimally, as desired by the publisher. Thus, the publisher may ensure that the terms of the license with respect to appearance (format) of the copy are adhered to exactly, and not left to the licensee to make the copy in a manner that complies with the publisher’s terms. This is not taught, suggested, or motivated by Johnson. Johnson does not address at all the question of whether or how the customer might get any needed copy, or whether the copy would comply with the publisher’s terms for what elements must accompany the copy. The benefit to the publisher of being able to maintain control over optimal format of each re-use of a work of authorship is a surprising result that would

not occur to a person of skill in the art when they think about whether it might be a good idea to deliver an electronic copy of the work when a license is obtained for a re-use.

Without rationale, the examiner baldly asserts that it would be obvious to change the Johnson system to store copies of all the publishers' works of authorship and then send copies of them to licensees upon request. But the examiner cites no prior art that talks about assembling onto one or more servers copies of a plurality of works of authorship from a plurality of publishers. Johnson does not suggest that such a library might be assembled, or that the copies can be automatically delivered from any server. There is no prior art cited by the examiner that suggests the assembling of such a library.

Claims 126 and 138 are allowable because the benefit to publishers of having control over the format of each re-used copy that results from delivering a fresh copy when a re-use license is granted is a surprising result. Also, the examiner has not made a prima facie case because she has not cited any prior art teaching the assemblage of a set of a plurality of works of authorship from each of a plurality of publishers.

Claims 133 – 135 and 139-141

Claim 126 does not specify anything about content of the copy that is transmitted after a license is obtained, as the publisher is free to adjust this content as it wishes. In addition to inventing the method whereby such a copy is transmitted, the Applicant also invented a method of making it easy for readers of the document to read an assertion that a license was obtained and access the license verification pages. That method is to put a hot spot in the published licensed copy which, if clicked on, takes a viewer to the license verification web page. These additional features are specified in claims 133, 134, and 135:

133 The method of claim 126 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

134. The method of claim 126 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

135. The method of claim 134 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

Claims 139, 140, and 141 are equivalent to these but in system form.

Claims 133 and 139 stand rejected on a combination of Johnson and Holmes (US patent #6,119,108). Neither Johnson nor Holmes teaches that an electronic copy of a licensed work might be sent to the licensee when the licensee obtains a license. As discussed above, this combination provides a synergy of considerable benefit to the publisher/licensor of ensuring that the copy has a desired format and includes a badge of approval as specified in these claims. When these badges of approval become ubiquitous, they will encourage copyright compliance.

Claims 134, 135, 140 and 141 stand rejected on a combination of Johnson and publications about a system called "Digital Object Identifier" ("DOI").

As pointed out by the examiner, DOI teaches that directing a browser to a URL stated on a document might take a viewer to a web page where a license can be obtained. However, neither Johnson nor the DOI references teach that clicking on a hot spot can take the viewer of a licensed work to a page that verifies the license and neither teaches that a copy with such a hotspot might be delivered when the license is obtained.

As specified in claims 135 and 141, the "lookup" is initiated from the licensed copy itself. Neither Johnson nor DOI anticipates placing a licensing verification link ID on the copy itself. In Johnson, not only is the owner the only one with access to the database, but if Johnson did write a report to allow anyone to access that database, how would a user do that? The user would not be able to do it from the work itself as with the applicant's claims 135 and 141. They would have to navigate to a website hosted by Johnson, then do a search using the name of the person who has the copy,

the name of the publisher, and an identifier of the article to see if that copy was authorized. That is a HUGE advantage of the applicant's invention over the prior art. No such search is needed with applicant's invention as specified in claims 135 and 141. One does not even need to know the copier's name. One just needs to click on a hot spot or enter the ID (which is a URL) into a browser to see if the license is valid. This ease of checking on validity of a license produces the surprising result of encouraging copyright compliance.

Claims 128 and 142

The essential question is whether it was obvious to modify the Elsevier service to be performed automatically, without human intermediation, and combine it with a server for granting reprint licenses on a plurality of works of authorship assembled from each of a plurality of publishers (a clearinghouse) such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then automatically be sent by the server system to a printer for printing on paper and delivery. The examiner cites no prior art about assembling a plurality of copies of works of authorship from each of a plurality of publishers. These elements by themselves are novel (although the examiner thinks they are taught by Johnson). The claim goes further and specifies establishing a system for automatic delivery of copies of the works from the assemblage to a printer for printing and delivery as part of a transaction to obtain a license.

A combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance and neither reference teaches assembling the set of many works from many publishers from which the copies might be sent.

On page 9 of her brief the examiner makes an incorrect assertion about the disclosure of Johnson. She says, at paragraph (f), that the server system of Johnson "allows copying of the work of authorship for printing on paper". Assuming the word "allows" as used by the examiner (its not in the claim) has meaning in the physical

world and means something like “enables to happen”, there is no such disclosure in Johnson. Each of the parts of Johnson cited by the examiner have been discussed above. They teach that a right to make a copy is granted and not that a copy is sent and not even that the system has access to a copy so that it could allow access to a copy if it were programmed to do so.

Claims 128 and 142 are therefore allowable.

Claims 136, 137, 143, and 144

Claim 128 does not specify anything about content of the copy that is transmitted after a license is obtained. In addition to inventing the method whereby such a copy is transmitted automatically without need for human mediation, the Applicant also invented a method of making it easy for readers of the printed document to learn that a license was obtained and to access a license verification web page. That method is to print a URL in the printed licensed copy which, if entered in a browser, takes a viewer to the license verification web page. These additional features are specified in claims 136 and 137:

136. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

137. The method of claim 136 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

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Claims 143 and 144 are the same but in system form.

The arguments above about claims 133, 134, and 135 also apply here. Neither Johnson nor DOI discloses anything about license verification web pages or the assemblage of a set of a plurality of works of authorship from a plurality of publishers.

Respectfully submitted,

/Paul F. Rusyn/

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Appendices:

Claims Appendix (9 pages)
Evidence Appendix (2 pages)
 - Rule 131 Affidavit (8 pages)
Related Proceedings Appendix (2 pages)

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